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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/334,163	06/16/1999	BRUCE NAGEL	MPS-411XC1	5018

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EXAMINER

COLLINS, CYNTHIA E

ART UNIT	PAPER NUMBER
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1638

21

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

09/334,163

Applicant(s)

NAGEL, BRUCE

Examiner

Cynthia Collins

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the corresp ndence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 April 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,10,11,16 and 18-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,10,11,16 and 18-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The Amendment filed July 17, 2002, paper no.16, has been entered.

Claims 1, 4, 5, 6, 10, 11 and 16 and 18-22 are newly amended.

Claims 23-27 are newly added.

Claims 7-9 are cancelled.

Claims 1-6, 10-11, 16 and 18-27 are pending and are examined.

All previous objections and rejections not set forth below have been withdrawn.

### ***Claim Rejections - 35 USC § 112***

Claims 23, 26 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are drawn to a method for developing a corn plant, to an F1 hybrid seed produced by crossing a corn plant according to claim 6 with another, different corn plant, and to an F1 hybrid plant grown from said seed.

The claimed invention lacks written description under current written description guidelines. The claims are drawn to F1 hybrid seed and plants having no identifying characteristics, whereby only one parental line is disclosed, yet the specification does not describe the genotypic or phenotypic characteristics of any F1 hybrid seed and plants. The claims are also drawn to a method for developing a corn plant of unspecified genotype or phenotype that

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reads the use of multiple generations of plants that have been outcrossed with multiple unspecified, undefined partners, yet the specification does not describe the genotypic or phenotypic characteristics developed by such a method, or the genotypic or phenotypic characteristics of outcrossed plants used in a corn breeding program in which a corn plant of claim 6 serves as a source of plant breeding material. If the claimed seed and plants cannot be identified by characteristics clearly disclosed in the specification, then it would be impossible to determine whether or not a plant of unknown parentage is covered by the claims. Breeding techniques can result in genotypically and phenotypically different plants wherein the identifying characteristics for the resultant offspring are highly variable. In view of the fact that only one F1 hybrid parental line is disclosed, and in view of the fact that no identifying characteristics are set forth in the claims, there is a lack of written description for the claimed F1 hybrid seed and plants. Furthermore, in view of the fact that the specification does not describe the genotypic or phenotypic characteristics developed by such a method, or the genotypic or phenotypic characteristics of outcrossed plants used in a corn breeding program in which a corn plant of claim 6 serves as a source of plant breeding material, there is a lack of written description for the claimed method.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 6, 16 and 23, and claims dependent thereon, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 1, 6 and 16 are indefinite in the recitation of “the group consisting of LS0417 (ATCC Accession No. PTA-1397), LS1498 (ATCC Accession No. PTA-1396), LS288 (ATCC Accession No. PTA-3642),”. It is unclear whether the group would include corn lines other than LS0417 (ATCC Accession No. PTA-1397), LS1498 (ATCC Accession No. PTA-1396) and LS288 (ATCC Accession No. PTA-3642). If Applicant intends that the group include only corn lines LS0417 (ATCC Accession No. PTA-1397), LS1498 (ATCC Accession No. PTA-1396) and LS288 (ATCC Accession No. PTA-3642), it is suggested that the claims be amended to insert -- and-- before “LS288”. See MPEP 2173.05(h).

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. Claim 23 omits the essential breeding steps required to develop a corn plant by breeding a corn plant of claim 6. It is unclear what additional plants would be required to practice the claimed invention, it is unclear how many generations of crosses would be performed, and it is unclear which plants would be crossed in which order to produce the desired corn plant.

### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26 and 27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stelpflug et al. (U.S. Patent No. 5,569,820, issued October 29, 1996).

The claims are drawn to an F1 hybrid seed produced by crossing a corn plant according to claim 6 with another, different corn plant, and to an F1 hybrid plant grown from said seed.

Stelpflug et al. teach F1 hybrid corn seed and F1 hybrid plants (columns 19-20 claim 9). While Stelpflug et al. do not teach that their F1 hybrid seed was produced by crossing a corn plant according to claim 6 with another, different corn plant, the claimed F1 hybrid seed and plant would read on any corn F1 hybrid seed or plant, as the claims do not set forth any characteristics that would distinguish them from other corn F1 hybrid seed or plants. See *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), which teaches that a product-by-process claim may be properly rejectable over prior art teaching the same product produced by a different process, if the process of making the product fails to distinguish the two products.

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***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Remarks***

No claim is allowed.

Claims 1-6, 10-11, 16 and 18-25 are deemed free of the prior art due to the failure of the prior art to teach or suggest a corn plant belonging to a corn line selected from the group consisting of LS0417 (ATCC Accession No. PTA-1397), LS1498 (ATCC Accession No. PTA-1396), and LS288 (ATCC Accession No. PTA-3642).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (703) 605-1210. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

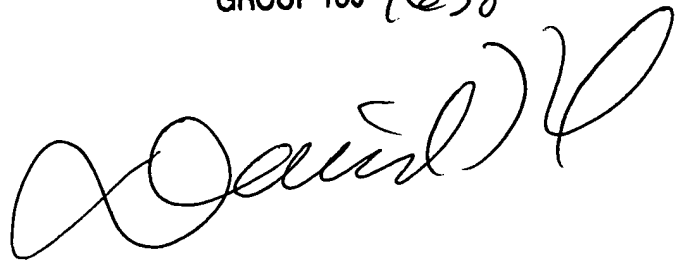
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

CC  
June 12, 2003

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 180-1638

A handwritten signature in black ink, appearing to read "David T. Fox", written over the printed name and title.